

REMARKS:

Claims 2-11, 13-21, and 23-31 are currently pending in the application. Claims 2-11, 13-21, and 23-31 stand rejected under 35 U.S.C. § 101. Claims 1-31 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,587,969 B1 to Weinberg et al. (*Weinberg*).

By this Amendment, independent claims 2, 13, and 23 have been amended to more particularly point out and distinctly claim the Applicants invention. In addition, dependent claims 3, 14, and 24 have been amended to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent application of substantially the same scope of originally filed independent claims 1-31. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 101:

Claims 2-11, 13-21, and 23-31 stand rejected under 35 U.S.C. § 101 as allegedly being directed towards non-statutory subject matter.

Although the Applicants believe claims 2-11, 13-21, and 23-31 are directed to patentable subject matter without amendment, the Applicants have amended independent claims 2, 13, and 23 to more particularly point out and distinctly claim the Applicants invention. In addition, dependent claims 3, 14, and 24 have been amended to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action.

It appears that the Examiner is basing the 35 U.S.C. § 101 rejection on an alleged failure to be “***within the technological arts.***” (23 February 2006 Office Action, Pages 2-3). The Applicants respectfully disagree.

However, the Board of Patent Appeals and Interferences has recently ruled that no such test exists:

Our determination is that ***there is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under § 101.*** We decline to propose to create one. Therefore, it is apparent that ***the examiner’s rejection can not be sustained.***

Ex parte Lundren, Appeal No. 2003-2088, Application 08/093,516 (Precedential BPAI opinion September 2005). (Emphasis Added).

Thus, it is respectfully submitted that the present rejection is based on an improper test. Accordingly, reconsideration and withdrawal of the rejection of claims 2-11, 13-21, and 23-31 under 35 U.S.C. § 101 are respectfully requested.

In addition, the Applicants respectfully request that the Examiner call the undersigned at (817) 447-9955, if the Examiner has additional comments or suggestions to the 35 U.S.C. § 101 rejection of the subject Application or if the Examiner believes it would be easier to discuss the 35 U.S.C. § 101 rejection over the telephone.

REJECTION UNDER 35 U.S.C. § 102(e):

Claims 2-11, 13-21, and 23-31 stand rejected under 35 U.S.C. § 102(e) over *Weinberg*.

Although the Applicants believe claims 2-11, 13-21, and 23-31 are directed to patentable subject matter without amendment, the Applicants have amended independent claims 2, 13, and 23 to more particularly point out and distinctly claim the Applicants invention. In addition, dependent claims 3, 14, and 24 have been amended to more particularly point out and distinctly claim the Applicants invention. By making these

amendments, the Applicants does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(e), as set forth in the Office Action.

The Applicants respectfully submit that *Weinberg* fails to disclose each and every limitation recited by claims 2-11, 13-21, and 23-31. The Applicants further submit that claims 2-11, 13-21, and 23-31 patentably distinguish over *Weinberg*. Thus, the Applicants respectfully traverse the Examiner's rejection of claims 2-11, 13-21, and 23-31 under 35 U.S.C. § 102(e) over *Weinberg*.

***Weinberg* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

For example, with respect to amended independent claim 2, this claim recites:

A computer-implemented method for selecting members in a hierarchy, the method performed using a computer system comprising one or more processing units and one or more memory units, the method comprising:

receiving input of a user from a member selection interface;

determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members, ***the hierarchy of members being associated with a particular dimension of an organization of data;***

recording the sequence of actions of the user in a member selection script, and

executing the recorded member selection script to ***generate a new selection of members*** based upon the members and hierarchical relationships of the users original inputs, ***after the hierarchy of members has been modified***. (Emphasis Added).

Independent claims 13 and 23 recite similar limitations. *Weinberg* fails to disclose each and every limitation of independent claims 2, 13, and 23.

The Applicants respectfully submit that *Weinberg* has nothing to do with amended independent claim 2 limitations regarding a ***“computer-implemented method for selecting members in a hierarchy”*** and in particular *Weinberg* has nothing to do with

amended independent claim 2 limitations regarding **“receiving input of a user from a member selection interface”**. In particular, the Examiner equates **“receiving input of a user from a member selection interface”** recited in amended independent claim 2 with “the user interface” disclosed in *Weinberg*. (23 February 2006 Office Action, Page 4). However, **the user interface disclosed in Weinberg** is merely a user interface of a testing tool that allows the user to define verification steps to automatically test for expected server responses during test execution, and **does not include, involve, or even relate to a member selection interface, as recited in amended independent claim 2**. (Abstract). In contrast, the **“member selection interface”** recited in amended independent claim 2 **provides a user with the ability to navigate through a hierarchy of members and select particular members the user desires for a particular function**. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Weinberg* and amended independent claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 2 from *Weinberg*.

The Applicants further submit that *Weinberg* has nothing to do with amended independent claim 2 limitations regarding **“determining a sequence of one or more actions** associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members, **the hierarchy of members being associated with a particular dimension of an organization of data”**. In particular, the Examiner equates **“the hierarchy of members being associated with a particular dimension of an organization of data”** recited in amended independent claim 2 with the server screen disclosed in *Weinberg*. (23 February 2006 Office Action, Page 4). However, the server screen **disclosed in Weinberg** is merely a separate window that is displayed to the user and **has nothing to do with a particular dimension of an organization of data**, as recited in amended independent claim 2. (Column 3, Lines 11-36). In contrast, **“the hierarchy of members being associated with a particular dimension of an organization of data”** recited in amended independent claim 2 allows a user to select a particular data dimension from which members are to be selected and may include, but is not limited to, a product dimension, a geography dimension, and a

time dimension. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Weinberg* and amended independent claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 2 from *Weinberg*.

The Applicants still further submit that *Weinberg* has nothing to do with amended independent claim 2 limitations regarding **"recording the sequence of actions of the user in a member selection script"**. Rather, *Weinberg* discloses a testing tool for testing the functionality of a transactional server where a recorder module merely records a series of user steps. (Abstract, Figures 6A-6C). The testing tool in *Weinberg* merely **displays these recorded user steps to allow for verification of expected server responses** and fails to disclose, teach or even hint at **recording the sequence of actions**, as recited in Applicants claims. (Abstract). In fact, *Weinberg teaches away from the claimed invention* because the recorder module of *Weinberg* merely records the particular members that the user selects, i.e. business process steps. (Figures 6A-6C). Thus, *Weinberg* cannot provide for **"recording the sequence of actions of the user in a member selection script"**, since *Weinberg* does not even teach, suggest, or hint at recording the sequence of events (actions) that the user went through to determine the members that are selected.

In addition, the Examiner equates **"recording the sequence of actions of the user in a member selection script"** recited in amended independent claim 2 with storing the user steps in memory disclosed in *Weinberg*. (23 February 2006 Office Action, Page 4). However, storing the user steps in memory disclosed in *Weinberg* is merely for recording the particular members that the user selects and **has nothing to do with recording the sequence of actions of the user**, as recited in Applicants claims. (Figures 6A-6C). In contrast, **"recording the sequence of actions of the user in a member selection script"** recited in amended independent claim 2 is based on the sequence of events that the user went through to determine the members that were selected. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Weinberg* and amended independent

claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 2 from *Weinberg*.

The Applicants yet further submit that *Weinberg* has nothing to do with amended independent claim 2 limitations regarding “executing the recorded member selection script to **generate a new selection of members** based upon the members and hierarchical relationships of the users original inputs, **after the hierarchy of members has been modified**”. Rather, *Weinberg* discloses creating a test script when the recorder module records the particular members that the user selects. (Figures 6A-6C). *Weinberg* merely discloses a hard coded set of members used to perform a particular business process which may become out of date and have to be recreated when members of *Weinberg*’s hierarchical dimension are added or deleted. *Weinberg* does not disclose, teach, or suggest executing this sequence of events (actions) once the hierarchy is modified and thereafter produce a new selection of members that satisfies the user’s original intent. Thus, *Weinberg* cannot provide for “executing the recorded member selection script to **generate a new selection of members** based upon the members and hierarchical relationships of the users original inputs, **after the hierarchy of members has been modified**”, since *Weinberg* does not even provide for (1) recording the sequence of events (actions) that the user went through to determine the members that are selected; or (2) executing this sequence of events (actions) once the hierarchy is modified and thereafter produce a new selection of members that satisfies the user’s original intent.

In addition, the Examiner equates “**after the hierarchy of members has been modified**” recited in amended independent claim 2 with modifying nodes disclosed in *Weinberg*. (23 February 2006 Office Action, Page 4). However, modifying nodes **disclosed in Weinberg** is merely provided for editing properties of the nodes to modify the test and **has nothing to do with after the hierarchy of members has been modified**. (Column 25, Lines 20-49). In contrast, “**after the hierarchy of members has been modified**” recited in amended independent claim 2 is related to recreating the desired member selections when the underlying hierarchical structures change. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s

comparison between *Weinberg* and amended independent claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 2 from *Weinberg*.

The Applicants respectfully submit that the allegation in the present Office Action that *Weinberg* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Weinberg* is considered to anticipate all of the limitations in claims 2-11, 13-21, and 23-31. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added). With respect to the subject application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of the Applicants claimed invention is identically shown in *Weinberg*. For example, the Examiner asserts that ***"the hierarchy of members being associated with a particular dimension of an organization of data"***, in amended independent claim 2 is somehow equivalent to a screen object of the sever screen. (23 February 2006 Office Action, Page 4). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. In another example, the Examiner asserts that ***"recording the sequence of actions of the user in a member selection script"***, in amended independent claim 2 is somehow equivalent to merely recording the particular members that the user selects. (23 February 2006 Office Action, Page 4). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. In still another example, the Examiner asserts that ***"after the hierarchy of members has been modified"***, in amended independent claim 2 is somehow equivalent to modifying nodes (i.e. editing properties of the nodes to modify the test). (23 February 2006 Office Action, Page 4). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. The Applicants respectfully point out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of anticipation in

claims 2-11, 13-21, and 23-31 under 35 U.S.C. § 102 with respect to *Weinberg* because *Weinberg* fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claims.

The Applicants Claims are Patentable over *Weinberg*

With respect to independent claims 13 and 23 these claims includes limitations similar to those discussed above in connection with amended independent claim 2. Thus, independent claims 13 and 23 are considered patentably distinguishable over *Weinberg* for at least the reasons discussed above in connection with amended independent claim 2.

Furthermore, with respect to dependent claims 3-11, 14-21, and 24-31: claims 3-11 depend from amended independent claim 2, dependent claims 14-21 depend from independent claim 13, and dependent claims 24-31 depend from independent claim 23 are also considered patentably distinguishable over *Weinberg*. Thus, dependent claims 3-11, 14-21, and 24-31 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicants respectfully submit that independent claims 2, 13, and 23 and dependent claims 3-11, 14-21, and 24-31 are not anticipated by *Weinberg*. The Applicants further respectfully submit that independent claims 2, 13, and 23 and dependent claims 3-11, 14-21, and 24-31 are in condition for allowance. Thus, the Applicants respectfully requests that the rejection of claims 2-11, 13-21, and 23-31 under 35 U.S.C. § 102(e) be reconsidered and that claims 2-11, 13-21, and 23-31 be allowed.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.

3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time,

and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an

"experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

5/4/06
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